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P-A856

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the patent application of

Howard S. Barnett

Inventor: Howard S. Barnett

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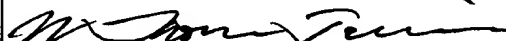
Title: PORTABLE VIDEOCONFERENCING SYSTEM

Examiner: Anthony Tyson/Melur. Ramakrishnaiah

Art Unit: 2643

Facsimile: 703-872-9313

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W. Thomas Timmons

FIRST AMENDED APPEAL BRIEF

Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

Sir:

- (i) Real Party in Interest: Howard S. Barnett, the inventor, and Designs that Compute, Inc., a small business entity.
- (ii) Related Appeals and Interferences: None
- (iii) Status of Claims: Claims 1-5 remain in the case. All claims stand rejected.
- (iv) Status of Amendments: All amendments have been entered.
- (v) Summary of Claimed Subject Matter: The five claims form one group. Claim 1 is the only independent claim. Claim 1 is for a system used in teleconferencing presentations. The system is portable. It includes a cart, and

the cart forms a podium. Everything else that is needed for teleconferencing presentations is included on the cart. Dependent claims 2, 3 and 4 include cameras for the presenter and for documents. Dependent Claim 5 includes projectors which project images from the cameras for the benefit of a live audience at the same time as the teleconference.

- (vi) Grounds of Rejection to be Reviewed on Appeal: Claims 1-5 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,767,897 (Howell) in view of U.S. Patent No. 5,489,938 (Maruyama et al.).

Issues: The Examiner's position was stated in the Final Rejection, "Regarding Claim 1, Howell discloses a system for teleconferencing presentation by presenter, comprising in combination: a cart forming a podium (22, fig. 1, col.3 lines 17-18), a computer located (32, figs. 1-2) in or on the cart (col. 3 lines 47-53), a touch panel interface (28, fig. 2, col. 3 lines 65-67, col. 4 lines 1-14) and a CODEC (30, fig.2) operationally attached to the computer, wherein the computer, the touch panel and the CODEC can be used without removing from the cart (fig. 1, col. 3 lines 40-44).

"Regarding claims 2-5, Howell further teaches the following: a first camera (76, fig. 1) is mounted on the cart, wherein the first camera can be used without removing from the cart (col. 4 lines 14-15), a second camera (70, fig. 1) located on or in the cart, for imaging of documents, wherein second camera can be used without removing from the cart (col. 4 lines 18-19). Projector in (22, fig. 1) associated with the cart and a screen, wherein the projector projects images from the first or second camera to the screen, wherein projector can be used without disassociating from the cart (col. 7 lines 15-67, col.8 lines 1-6).

"Howell differs from the claimed invention in that he does not explicitly teach a portable system for teleconferencing.

“However, Maruyama discloses a television teleconference system which teaches portable system for teleconferencing (fig. 3, col. 4 lines 16-31).

“Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Howell’s system to provide portable system for teleconferencing as the arrangement would provide easy portability of the teleconferencing system, thus reducing the time and labor necessary for transportation of the system as taught by Maruyama.

At issue is the conclusion of obviousness as well as what is truly disclosed in the references.

(vii) Argument:

The five claims form one group. Claim 1 is the only independent claim.

Howell Patent 5,767,897, Video Conferencing System June 16, 1998.

The Howell patent integrates a room teaching system. The patent teaches a specific controller 22 which can control both the local conference as well as a Multimedia Conference Unit (MCU). This type of controller has the benefit of allowing a user full control over the conference. The User can use a touch panel 27 of video display section 26 to control their local transmission, changing camera, selecting their VCR for replay. The panel also allows the user to stage the next transmission by use of a preview window. Ultimately, the control unit operates a device that links more than two participants into a single videoconference, known as an MCU.

As seen pictorially from the figures, the Howell patent does not address transportability of videoconferencing from one room to another. Although “podium” 23 appears to have some sort of casters, they are not numbered or mentioned in the patent. The disclosure suggests a device that is built into a room in which it is used. The transportability of a videoconferencing system is not addressed by the patent. Transportability does not appear in the claims as well. The words “portable,” “movable” and “cart” do not appear in the Howell patent. Assuming that what is shown are casters are wheels, a podium with wheels still does not a “cart” make.

Both the Howell patent and the present patent disclosure address what appears to be primarily a teaching environment. Both designs have preferred embodiment where a user, which could be an instructor, control the classroom from a single spot. Both have the goal of a central control console that is easily accessible during the conference in a way that the primary user can control the conference without serious interruption to their ability to present at that conference.

This similarity is where these two inventions end. The Howell patent discloses an apparatus which contains a controller. This controller has specific attributes such as a preview display, a presentation display, and a control section.

The present patent application addresses the portability of the device, and how to contain the proper equipment in an easily portable configuration. The present application could actually use the controller that is contained within the Howell patent or use a controller of different design. The equipment of the Howell patent is not a requirement for the proper operation of the device disclosed in the present patent application. Further, the drawings and discussion in the Howell patent illustrate the state of the art at the time of filing the present application as well. Most products were slated for non-transportable or not easily transportable systems, using multiple carts or cabinets to house all the equipment necessary for a videoconference.

The claims have been amended to specify that it is “A portable system for teleconferencing presentations” and that “the computer, the touch panel and the CODEC can be used without removing them from the cart” in the independent claim. In Claim three, the limitation is added that “the first camera can be used without removing it from the cart.” In Claim 4, the limitation is added that “the second camera can be used without removing it from the cart” and in Claim 5, that “the projector can be used without disassociating it from the cart.”

Marumaya Patent 5,489,938 Television Conference Apparatus Including Picturing Device. Feb 6, 1996

The Marumya et al. patent teaches an apparatus for television conferencing. The key component and uniqueness of this apparatus is a compact packaging technique. This patent integrates what is now referred in the industry as a document

camera (in the patent disclosure this is referred to as a material picturing device). Using a document camera within a videoconference was not unique at the time. Figure 2A and figure 2B shows a common device (a document camera), which was known in the art and would transmit document images.

The uniqueness of the Marumaya et al. patent is the integration of the device into the cabinet. This is seen as the essential component of the patent as (Column 3, line 65) “A manuscript table for placing materials and samples is provided on one side of the cabinet **24** and can be retracted into the cabinet **24**. A video camera device **26** is attached, as the second camera means, to one end of an arm member **27** which arm can be retracted inside the cabinet **24**. and positioned above the table **25**. The essence of the patent is truly a retractable document camera. “

The need for this integration is further emphasized with every figure of the embodiments of the patent show a retractable document camera (Figures 3a, 3b, 5a, 5b, 6a, 6b, 7a, 7b, 8a, 8b.) The differences of these figures are the differences in how this camera is integrated in the cabinet.

Clearly the necessary components for the Marumaya et al. patent require a cabinet with multiple compartments; a table which can be retracted but when opened is supported by a handle, and camera which can be positioned over the table.

The present patent disclosure does not contain any of these components. The system disclosed does not necessarily contain a cabinet with multiple compartments. In one of the preferred embodiments, the device contains only one compartment.

Further, the disclosure of the current patent application does not necessarily contain a retractable table that is used as the base for the document camera, and that if there is a retractable table on the device, that table does not necessarily require a handle for support. Also the second camera is not an integral part of the cabinet, having the cabinet designed to retract the device into the cabinet. The invention disclosed uses a smaller commercial document camera. In the preferred embodiment, the commercial document camera is placed on the work surface of the apparatus.

The Maruyama et al. patent does support the validity of the present application. It shows that there is precedence for granting a patent for videoconferencing devices, which combines a standard set of interfaces to a

videoconferencing device repackaged in a unique way. This new device has unique advantages in terms of portability and functionality.

In Maruyama et al. patent, a videoconferencing CODEC, and a document camera are combined (optionally with a microphone, camera, facsimile machine, keyboard device and monitor device) in a cabinet so that they can be transported in a single cabinet, i.e. for transportation only.

In the present application, the same devices are combined for transportability and functionality, which is also key. All the devices which are mentioned in the Maruyama et al. patent can be combined in the present patent application apparatus. These would include but not be limited to a Camera, a Monitor device, a microphone; a facsimile device, and a VCR (as well as a Personal Computer). Both the Maruyama et al. patent and the present application combine these devices on a single transport device. In the present application the monitor is replaced with a projector device. (Optionally if there is a fixed monitor system in the room, the projector device does not have to be included in the apparatus.)

The fundamental difference in the design of the cabinet in the Maruyama et al. patent and the cart in the present patent application would be that the configuration in the present patent application is designed to be used by an instructor as the lectern for teaching while this was never conceived on the Maruyama et al. patent. In the present patent application, all components are in easy reach.

This configuration of the present application has many advantages which were never conceived in the Maruyama et al. patent. In the Maruyama et al. patent, the cabinet is designed for a participant in a conference room to operate the equipment from a desk in the conference room (Column 4, lines 59-63). As can be seen from the figures showing the preferred embodiments, the operators would have to get up from where they were seated to use any of the devices transported in the Maruyama et al. patent. Moreover, moving to that position, most probably cause the operator to be positioned out of camera view and at an very inconvenient place to see what is on the monitor. For example the document camera is on the side of the monitor. To effectively use this device the operator would have to be standing next to the monitor, very probably out of camera range and at a position, which would make it

inconvenient to use the monitor. To use the facsimile machine the operator would have to be standing or crouching in front of the monitor.

The present patent application solves these problems by designing the cabinet (or cart) as the spot in which to perform the lecture. Therefore it is natural for person running the conference to be standing at the control near the document camera, facsimile machine, personal computer, or VCR. This is accomplished by placing the image of the distant end away from the cabinet rather than on it. In the preferred embodiment, the camera is placed on a tripod located at a distance away and a projector or projectors attached to the cart can be used to project the images away from the cart. Other embodiments can keep the camera mounted on the cart and/or attaching to room mounted projectors or monitors to handle the viewing of the monitor device.

In brief both the Maruyama et al. patent and the present patent application solve the one fundamental problem: the easy transportability of videoconferencing devices from one room to another. The Maruyama et al. patent solves this problem by creating a unique document camera.

The present patent application solves the problem by changing the entire usage of the portable device. The device is changed from a cabinet used to house the equipment and the monitor to a device designed as a podium for presentations. This has the following advantages:

- All devices can be used by a user without the need for moving from their location
- When the devices are used the user can retain control of conference. The user can be seen by the distant end as well as seeing other participants.
- The device can be lighter because no monitor is employed
- Again because of the lack of monitor there is a workspace available for a document camera, controller, or as a place to put documents.
- The product is inherently lighter making it easier to transport.

Conclusion

Both Maruyama and Howell, validate the uniqueness of the present patent disclosure. Maruyama demonstrates the uniqueness of a portable device. This uniqueness is born out in that Howell is not portable at all. Howell shows the need for a teaching device that allows an instructor to control the classroom from a single point. However the Howell apparatus is far from portable, constraining the lessons to be taught in a single room. Without the portability, a school must have a special classroom, which deals primarily with distance education. This takes space, which the school may not have. Further a classroom such as this may not be conducive for learning in a primary school environment.

The present invention allows for a portable teaching system that lets the instructor control the devices necessary for teaching without moving off camera or into an uncomfortable position. The system is easily transported from classroom to classroom.

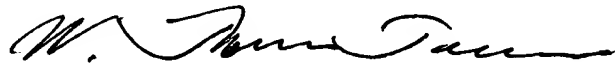
Several factor have combined to enable this apparatus. Not all of these factors are necessary for transportability but all serve to make the devices more functional and commercially viable.

- The reduction in the size of the equipment: the claims are specifically limited to “a cart”
- The reduction and increased performance of projection systems: allowing the claims to limit the cart to “forming a podium”
- The use of computer networks to transmit videoconferencing. This allows wired or wireless networks that may be already in place in a school to be used for the communication between two devices. This in not a required component, since many networks can be constructed to attach video conferencing devices under more traditional networks, however is does make the devices more transportable since it is possible to move from one room to another with out special wiring that would not normally in the room.

It is believed that all of the claims are in condition for allowance, and an early indication of the allowance of claims 1-5 is earnestly requested.

This Revised Appeal Brief is submitted in triplicate. The original Brief on Appeal was accompanied by a Request for Extension of Time and a check to cover the extension and the \$160 fee for filing the Brief, which was the correct fee at that time. Please charge any additional fees which may be required or credit any over payment to Deposit Account No. 20-1123.

Respectfully,



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(viii) Claims Appendix

1. A portable system for teleconferencing presentations by a presenter, comprising in combination:
a cart forming a podium;
a computer located in or on the cart;
a touch panel interface with the computer, positioned on the cart, visible to the presenter; and
a CODEC operationally attached to the computer, wherein the computer, the touch panel and the CODEC can be used without removing them from the cart.
2. A portable system according to Claim 1, further comprising a first camera for taking a video image of the presenter.
3. A portable system according to Claim 2 wherein the first camera is mounted on the cart, wherein the first camera can be used without removing it from the cart.
4. A portable system according to Claim 2, further comprising a second camera, located on or in the cart, for taking images of documents, wherein the second camera can be used without removing it from the cart.
5. A portable system according to Claim 4, further comprising a projector associated with and movable with the cart and a screen, wherein the projector projects images from the first or second camera to the screen, wherein the projector can be used without disassociating it from the cart.

(ix) Evidence Appendix
None.

(x) Related Proceedings Appendix
None.